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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,489	03/02/2004	Yasuhiro Koyanagi	170A 3545	1873

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QUINN EMANUEL URQUHART OLIVER & HEDGES, LLP
KODA/ANDROLIA
865 S. FIGUEROA STREET, 10 TH FLOOR
LOS ANGELES, CA 90017

EXAMINER

RONESI, VICKEY M

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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08/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/791,489	Applicant(s) KOYANAGI, YASUHIRO	
	Examiner VICKY RONESI	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/30/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. All outstanding rejections, except for those maintained below, are withdrawn in light of applicant's response filed on 6/5/2008.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. The new grounds of rejection set forth below are necessitated by applicant's amendment filed on 6/5/2008. In particular, claims 1 and 4 have been amended to include new matter. Thus, the following action is properly made final.

Claim Rejections - 35 USC § 112

4. Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to claims 1 and 4, the amount of polyvinyl acetate resin alone of 1 part by weight fails to satisfy the written description requirement of 35 USC 112, first paragraph since there does not appear to be a written description requirement of the amount of 1 part by weight with respect to polyvinyl acetate resin alone without it being in an emulsion in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163. While there is support for 1 part by weight polyvinyl acetate resin emulsion in the original claims, there is no support for 1 part by weight of polyvinyl acetate not in an emulsion. Note that original claim 1 recited sequentially mixing an emulsion of zirconium oxide, a liquid paraffin

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and an emulsion of polyvinyl acetate at a ratio of 1:4:1. That is, the 1 pbw of polyvinyl acetate in original claim 1 is actually 1 pbw of an emulsion of polyvinyl acetate not 1 pbw of (non-emulsified) polyvinyl acetate as presently claimed. Hence, the examiner's concern regarding non-compliance with the written description requirement.

With respect to claim 4, the amount of zirconium oxide alone of 1 part by weight fails to satisfy the written description requirement of 35 USC 112, first paragraph since there does not appear to be a written description requirement of the amount of 1 part by weight with respect to zirconium oxide alone without it being in an emulsion in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163. While there is support for 1 part by weight zirconium oxide emulsion in the original claims, there is no support for 1 part by weight of zirconium oxide not in an emulsion.

With respect to claims 2 and 3, they are rejected for being dependent on a rejected claim.

Claim Rejections - 35 USC § 103

5. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quemin (US 2005/0129639).

The rejection is adequately set forth in paragraph 5 of Office action mailed on 3/14/2008 and is incorporated here by reference.

Response to Arguments

6. Applicant's arguments filed 6/5/2008 have been fully considered but they are not persuasive. Specifically, applicant argues that (A) that Quemin discloses the use of other

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ingredients not used in the instant invention and (B) that Quemin does not disclose the presently claimed ratio.

With respect to argument (A), the instant claims are to other ingredients as suggested by open claim language “comprising.”

With respect to argument (B), Quemin discloses a makeup composition comprising 0.5-25 wt % pigment such as zirconium oxide (paragraphs 0108 and 0175); 0.5-40 wt % of an oil phase such as liquid paraffin (paragraphs 0090, 0100); and 0.01-5 wt % of a nonionic thickener such as a vinyl acetate copolymer (paragraph 0190 and 0201). These percentages provides for a ratio that overlaps with the presently claimed ratio of 1 : 4 : 1 when, for example, the composition comprising 5 wt % pigment, 20 wt % paraffin, and 5 wt % vinyl acetate copolymer. Applicant's conversion of the presently claimed ratio amounts to total weight % amounts is not applicable because Quemin teaches amounts that read on the presently claimed ratio.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

6/21/2008
Vickey Ronesi

/V. R./
Examiner, Art Unit 1796

/Vasu Jagannathan/
Supervisory Patent Examiner, Art Unit 1796